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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/161,478

09/28/98

TOYOSAWA

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1035-204

MM91/0531

EXAMINER

GRAYBILL, D

ART UNIT

PAPER NUMBER

2814

DATE MAILED: 05/31/01

NIXON & VANDERHYE  
1100 NORTH GLEBE ROAD  
8TH FLOOR  
ARLINGTON VA 22201-4714

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/161,478	TOYOSAWA ET AL.	
	Examiner	Art Unit	
	David E Graybill	2814	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 1998 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- |   |  |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other: _____                                    |

Figures 7(a)-15 should be designated by a legend such as -- Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The amendment filed 3-21-01 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is the amendments to claim 1 and 10, lines, 9 and 16-18; and claim 23, lines 6 and 11-13. To further clarify, any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983) *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion.

Applicant is required to cancel the new matter in the reply to this Office Action.

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Claims 1-19 and 23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The non-described subject matter is the amendments to claim 1 and 10, lines, 9 and 16-18; and claim 23, lines 6 and 11-13.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 4, 6, 7, 9-11, 13, 15, 18 and 23 are rejected under 35 U.S.C. 102(a) as being anticipated by applicant's admitted prior art.

At page 2, line 9 to page 16, line 8; and page 21, line 19 to page 23, line 4, applicant discloses that all of the essential elements of claims 1, 2, 4, 6, 7, 9-11, 13, 15, 18 and 23 are conventional. To further clarify, applicant teaches as conventional only a first insulating protective film 111, wherein no insulating film other than the first film covers the

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metal wiring pattern and the through hole on the metal wiring pattern side.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art.

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Applicant does not appear to explicitly teach the particular claimed panel size. Notwithstanding, it would have been an obvious matter of design choice bounded by well known manufacturing constraints and ascertainable by routine experimentation and optimization to choose this particular size because applicant has not disclosed that the size is for a particular unobvious purpose, produces an unexpected result, or is otherwise critical, and it appears prima facie that the product would possess utility using another dimension. Moreover, it has been held that limitations directed to size are prima facie obvious absent a disclosure that the limitations are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical. See, for example, *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984); *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art as applied to claims 1, 2, 4, 6, 7, 9-11, 13, 15, 18 and 23 supra, and further in combination with Kimura (5767571).

As cited, in particular, at page 3, lines 20-22, applicant teaches wherein the periphery of portions at which the tape carrier and the driving semiconductor elements have been electrically connected is covered with resin 115 having an insulating property in a manner so as to allow the edge of the resin to make an angle of not more than  $70^\circ$  with the upper surface of the first insulating protective film. Although applicant does not appear to literally teach as conventional the claimed resin angle, it is noted that applicant teaches this angle with reference to Fig.1(b), and the prior art Fig.7(b) illustrates an identical resin angle.

Also, applicant does not appear to explicitly teach as conventional a liquid resin. Nonetheless, at column 7, lines 1-3 and 60-65, Kimura teaches a liquid resin 5, and further teaches wherein the periphery of portions at which a tape carrier 3 and driving semiconductor elements 1 have been electrically connected is covered with liquid resin 5 having an insulating property in a manner so as to allow the edge of the resin to make an angle of not more than  $70^\circ$  with the upper surface of the first insulating protective film. Moreover, it would have been obvious to combine the product of Kimura with the product of applicant's admitted prior art because it would reduce package size.

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Claims 3, 8, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art as applied to claims 1, 2, 4, 6, 7, 9-11, 13, 15, 18 and 23 supra, and further in combination with Miyamura (5441918).

Applicant does not appear to explicitly teach as conventional wherein the solder resist of the first insulating film contains a filler at the particular claimed wt%. Nevertheless, Miyamura teaches this limitation at column 5, lines 39-51. In addition, it would have been obvious to combine the product of Morisaki with the product of applicant's admitted prior art because it would provide a solder resist having desirable properties.

Applicant's remarks filed 3-21-01 have been fully considered and are adequately addressed in the rejection supra.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any




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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Any telephone inquiry of a general nature or relating to the status (MPEP 203.08) of this application or proceeding should be directed to the group receptionist whose telephone number is 703-308-1782.***

Any telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (703) 308-2947. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.

The fax phone number for group 2800 is 703/305-3431.



David E. Graybill  
Primary Examiner  
Art Unit 2814

D.G.  
30-May-01